

REMARKS

Status Of Application

Claims 42, 44, 46-50, 52, and 54, and 55 are pending in the application; the status of the claims is as follows:

Claims 42, 44, and 46-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,737,014 to Tojo et al ("Tojo") in view of U.S. Patent No. 4,897,732 to Kinoshita et al. ("Kinoshita").

Claims 50, 52, 54, and 55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tojo in view of Kinoshita as applied to claims 42, 44, and 46-49 above, further in view of U.S. Patent No. 4,709,385 to Pfeiler et al. ("Pfeiler").

Claims 42, 44, and 46-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,833 to Taka ("Taka") in view of U.S. Patent No. 5,034,804 to Sasaki et al. ("Sasaki").

Claims 50, 52, 54, and 55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Taka in view of Sasaki and Pfeiler.

Claims 42, 44, and 46-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinoshita in view of U.S. Patent No. 5,067,029 to Takahashi ("Takahashi").

Claims 50, 52, 54, and 55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinoshita in view of Takahashi and Pfeiler.

Claim Amendments

Claims 42, 47, 50 and 54 have been amended to more clearly point out and distinctly claim the subject matter of the invention. These changes do not introduce any new matter.

35 U.S.C. § 103(a) Rejections

The rejection of claims 42, 44, and 46-49 under 35 U.S.C. § 103(a), as being unpatentable over Tojo in view of Kinoshita, is respectfully traversed because the combination is improper and, even if proper, fails to teach all elements of the subject claims.

Tojo teaches an electronic camera having a small-capacity solid state memory and a large-capacity non-solid state memory, e.g. an optical disk. See Abstract. Both memories are removable. See Fig. 1 and Column 2, lines 18-20. In the Summary of the Invention, Tojo clearly articulates that an intended purpose for making both memories removable is so that a tourist does not have to carry around the big, heavy non-solid state memory while on a walking tour. Rather, the tourist may swap spare solid state memory items when they become full. See column 2, lines 26-31.

The Office Action proposes modifying Tojo to make one of the memories non-removable as allegedly shown by Kinoshita. However, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). It is respectfully submitted, that fixing either of the memories taught by Tojo as proposed would make the camera unsuitable for its intended purpose. If the solid-state memory was not removable, then the tourist on the walking tour would have to carry the non-solid state memory in case the small capacity solid state memory became filled. If, on the other hand, the non-solid state memory was not removable the camera would be heavy and bulky. Clearly

then, modifying Tojo to make one of the memories non-removable would render the camera unsuitable for Tojo's stated purpose. Accordingly, there can be no motivation to combine the references as proposed in the Office Action.

Moreover, even if Tojo and Kinoshita are combined, the combination still fails to teach all elements of the subject claims. For example, amended claim 42 recites, *inter alia*:

an image processor for processing image information
... and;
a changer for selectively changing between a first condition, in which image information on the first memory is outputted to the processor, and a second condition, in which image information on the second memory is outputted to the image processor, the processed image data being outputted to the reproduction device.

That is, image information from one of the first and second memories is selectively provided to the processor and the processed image information is outputted to the reproduction device. This feature of amended claim 42 is not taught by either Tojo or Kinoshita because neither reference teaches a camera including an image processor for processing image information. It is respectfully submitted, therefore, that amended claim 42 distinguishes over the combination of Tojo and Kinoshita, as do claims 44 and 46 which depend from claim 42.

Amended claim 47 recites, *inter alia*,

... an image processor ...

As applied above in regards to claim 42, this feature of claim 47 is not taught by the combination of Tojo and Kinoshita. It is respectfully submitted therefore that claim 47, as well as claims 48 and 49 which depend therefrom, distinguishes over the proposed combination.

Accordingly, it is respectfully requested that the rejection of claims 42, 44, and 46-49 under 35 U.S.C. § 103(a) as being unpatentable over Tojo in view of Kinoshita, be reconsidered and withdrawn.

The rejection of claims 50, 52, 54, and 55 under 35 U.S.C. § 103(a), as being unpatentable over Tojo in view of Kinoshita as applied to claims 42, 44, and 46-49 above, further in view of Pfeiler, is respectfully traversed based on the following.

Claims 50 and 54 each recite, *inter alia*:

... an image processor ...

As applied above in regards to claim 42, this feature of claims 50 and 54 is not taught by the combination of Tojo and Kinoshita. It is respectfully submitted that Pfeiler also fails to disclose an image processor as recited in the subject claims. Therefore claims 50 and 54, as well as claims 52 and 55 which depend therefrom, distinguishes over the proposed combination. Accordingly, it is respectfully requested that the rejection of claims 50, 52, 54, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Tojo in view of Kinoshita as applied to claims 42, 44, and 46-49 above, further in view of Pfeiler, be reconsidered and withdrawn.

The rejection of claims 42, 44, and 46-49 under 35 U.S.C. § 103(a), as being unpatentable over Taka in view of Sasaki, is respectfully traversed based on the following.

Amended claims 42 and 47 each recite, *inter alia*:

... an image processor

It is respectfully submitted that neither Taka nor Sasaki disclose an image processor. Therefore, claims 42 and 47 distinguishes the proposed combination of Taka and Sasaki, as do claims 44, 46, 48, and 49, which each depend from one of claims 42 and 47. Accordingly, it is respectfully requested that the rejection of claims 42, 44, and 46-49

under 35 U.S.C. § 103(a) as being unpatentable over Taka in view of Sasaki, be reconsidered and withdrawn.

The rejection of claims 50, 52, 54, and 55 under 35 U.S.C. § 103(a), as being unpatentable over Taka in view of Sasaki and Pfeiler, is respectfully traversed based on the following.

Claims 50 and 54 each recite, *inter alia*:

... an image processor ...

As applied above in regards to claim 42, this feature of claims 50 and 54 is not taught by the combination of Taka and Sasaki. It is respectfully submitted that Pfeiler also fails to disclose an image processor as recited in the subject claims. Therefore claims 50 and 54, as well as claims 52 and 55 which depend therefrom, distinguishes over the proposed combination. Accordingly, it is respectfully requested that the rejection of claims 50, 52, 54, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Taka in view of Sasaki and Pfeiler, be reconsidered and withdrawn.

The rejection of claims 42, 44, and 46-49 under 35 U.S.C. § 103(a), as being unpatentable over Kinoshita in view of Takahashi, is respectfully traversed based on the following.

Amended claims 42 and 47 each recite, *inter alia*:

an image processor ... and ...
a changer for selectively changing between a first condition, in which image information on the first memory is outputted to the image processor, and a second condition, in which image information on the second memory is outputted to the image processor, the processed image data being outputted to the reproduction device.

It is respectfully submitted that neither Kinoshita nor Takahashi disclose an image processor or a changer operable to selectively process and display image information from the first and second memories. It is respectfully submitted, therefore, claims 42 and 47 distinguishes the proposed combination of Taka and Sasaki, as do claims 44, 46, and 48-49, which each depend from one of claims 42 and 47. Accordingly, it is requested that the rejection of claims 42, 44, and 46-49 under 35 U.S.C. § 103(a) as being unpatentable over Kinoshita in view of Takahashi, be reconsidered and withdrawn.

The rejection of claims 50, 52, 54, and 55 under 35 U.S.C. § 103(a), as being unpatentable over Kinoshita in view of Takahashi and Pfeiler, is respectfully traversed based on the following.

Amended claims 50 and 54 each recite:

an image processor coupled to the internal memory for processing image information temporarily stored therein;

It is respectfully submitted that none of Kinoshita, Takahashi, and Pfeiler disclose, teach, or otherwise suggest an image processor coupled to an internal memory as claimed. It is respectfully submitted, therefore, that claims 50 and 54 distinguishes the proposed combination of Kinoshita, Takahashi, and Pfeiler, as do claims 52 and 55 which depend from claims 50 and 54. Accordingly, it is respectfully requested that the rejection of claims 50, 52, 54, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Kinoshita in view of Takahashi and Pfeiler, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.


Application No. 09/768,667
Amendment dated November 14, 2005
Reply to Office Action of May 20, 2005

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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